MATTHEW T. CHAPMAN and MARK C. CHAPMAN,

Petitioners,

vs.

JOHN A. WINTHROATH

BRIEF OF AMICUS CURIAE

JOHN C. CONNER,
DEAN S. EDMONDS,
CHARLES J. O'NEIL,
Counsel for Amicus

Supreme Court of the United States.

October Term, A. D. 1919.

No. 117.

MATTHEW T. CHAPMAN and MARK C. CHAPMAN,
Petitioners,

vs.

JOHN A. WINTROATH.

BRIEF FOR FULLER ENGINEERING COMPANY, AS AMICUS CURIAE.

The Fuller Engineering Company of Allentown, Pa., requests leave to file the following memorandum in support of the appeal taken herein.

At the outset, we wish to emphasize the far-reaching character of the estoppel which has been applied by the Court of Appeals of the District of Columbia in this case. It extends to and vitally affects the patent rights of many inventors and many investors in inventions. If sustained, it will unquestionably deprive of patent protection many inventors whose claim to the credit of their inventions could readily be established. In particular, we wish to point out that though the case at bar involves a consideration of so-called divisional applications for patents, the principle of estoppel here under review is in no way limited to cases in which such divisional applications are involved.

If the administration of the Patent Office could and did attain the perfection which is its constant aim, this doctrine of estoppel would be of little consequence. A situation in which it would be applicable would present itself but seldom and in those rare instances the application of the estoppel would probably operate to the ultimate good of the majority of those concerned. But that degree of perfection cannot be attained, as will be admitted by those who, like ourselves, look upon the administration of the Patent Office with a strong feeling of pride. Under such a perfect fulfillment of its functions by the Patent Office, it would seldom or never occur that an applicant for patent would have occasion to present in his application a claim of a patent which had been issued more than a year. Before the patent issued, officials of the Patent Office would note that there were two applicants soliciting patents for the same invention, and would institute an interference proceeding to determine which of the two applicants was the first inventor.

But long experience shows that it is impossible for the Patent Office to detect all instances of interference between co-pending applications for patents. The great number of applications filed in the Patent Office is one reason for this. Another is that the same invention is often embodied by two applicants for patents in mechanisms which are just enough different as to their uses to cause the two applications to be assigned to different Examiners in the Patent Office. Whatever the cause, it frequently happens that a patent is issued containing claims for an invention claimed by another whose application for patent was pending in the Patent Office concurrently with the application for the patent which was granted.

Under such circumstances, the applicant for patent, or his attorney, certainly should note the issuance of the patent claiming the invention; and he should forthwith demand an interference proceeding to determine the issue of priority between him and the patentee. But he does not always do so. Here again it is the great number of patents that are issued and the different forms in which the same invention may be embodied that are responsible for what might seem to be an inexcusable oversight. As a result, it might easily be and frequently is the case that the existence of the patent does not become known to the applicant until after the lapse of a year from the date of issue of the patent. Under such circumstances, the ruling of the Court of Appeals of the District of Columbia would deny to the applicant the right to present in his application the claims appearing in the patent and to contest an interference with the patentee to determine the ownership of the invention. We believe this would work a great injustice to the applicant and to the public; to the applicant because he would be prevented from obtaining adequate protection for his invention, and to the public because they would be made to pay tribute under a patent to one who was not the first inventor of the invention patented. To illustrate how this injustice could occur, we shall refer briefly to three cases in which this estoppel would be applicable. All three of these are typical of cases actually presented in connection with applications now pending before the Patent Office.

(1) A valuable invention was made by A, living in Boston, in 1916. Appreciating the value of his invention, A placed it upon the market at once, beginning in the district about his home

and spreading out gradually from there. By the end of the year 1916, A was satisfied that his invention was of value, and he filed an application for patent covering it. Early in 1917, B, living in San Francisco, made the same invention quite independently of A, and feeling that he did not care to exploit it unless he could get a patent covering it, he filed an application for patent immediately. By the middle of 1917, a patent was issued to B for the invention, the speedy issuance of B's patent being due to the fact that his application was free from any formal defect and was prosecuted vigorously. Of course the Patent Office should not have granted B's patent; the Examiner in charge of these applications should have noted that they were directed to the same invention and should have declared an interference between them to determine the issue of priority. The issuance of B's patent escaped the attention of A and his attorney until after a year had elapsed following the issuance of B's patent. Then when A learned of B's patent he perceived at once that the Patent Office had issued the patent improperly, that the application for B's patent had been filed subsequent to the filing of A's application, and that A had made the invention many months before he filed his application, so that in all probability, he, and not B, was the first inventor. The natural thing for A's attorney to do in such circumstances, and the thing which would have been done by any attorney conversant with the patent practice which has been followed in the Patent Office for generations back, would be to file in the patent an amendment of A's application requesting the insertion in that application of the claims of B's patent, stating in connection with the amendment that the claims were copied from the patent. This would call

to the attention of the Examiner his oversight in granting B's patent, and he would forthwith declare an interference between the patent and the application. In such an interference, the issue of priority of invention would be tried out, and if A were found to be the prior inventor, he would be granted a patent containing claims which were duplicates of the claims in B's patent. There would then be two patents outstanding for the same invention, but the record of the interference in the Patent Office would be available to the public for the purpose of ascertaining which of the two patents was valid. And either patentee could proceed against the other under Section 4918 of the Revised Statutes for the purpose of securing cancellation of his opponent's patent.

Under this doctrine of estoppel which has been announced by the Court of Appeals of the District of Columbia, this action of A in presenting the claims of B's patent in A's application and having an interference declared to determine the issue of priority would not be permitted. Instead, B's patent would appear to be the patent for the invention, although A had made the invention, and had put it upon the market long before the invention was made by B. Anyone familiar with A's commercial exploitation of the invention in 1916 could successfully defend against a suit brought by B for infringement of his patent. But A, the real inventor, would be deprived of protection for the invention afforded by claims in the form of the claims presented by B, and might be wholly unable to secure adequate protection for the invention under claims in the form of those originally presented by him in his application for patent. Thus protection would be denied to the true inventor and the public might be made to pay tribute under the patent

to B who was entitled to nothing because he was not the first inventor, or might be forced to contest a suit for infringement brought by B.

(2) A valuable invention was made by C who disclosed it to D, either inadvertently or in the effort to secure D's cooperation in exploiting the invention. D, who had invented nothing, filed an application for a patent covering the invention without informing C of it. A patent was granted to D. C did not know of D's application for the patent, nor did he become aware of the issuance of D's patent, but in his effort to obtain protection for the invention, he himself filed an application for patent. More than a year from the issuance of D's patent elapsed before C became apprised of the issuance of the patent, but immediately upon learning of it, C realized that it was he who had communicated the invention to D, and that D had practically stolen the invention from him. Under this doctrine of estoppel announced by the Court of Appeals of the District of Columbia, C would be denied any remedy through interference proceedings in the Patent Office. He would not be permitted to present in his pending application the claims of D's patent, and therefore would not be permitted to contest an interference proceeding with D. Furthermore, if this doctrine of estoppel were approved by the Supreme Court, C would have no remedy in a District Court under Section 4915 of the Revised Statutes. He would be dependent for protection upon such claims as he had presented in his application for patent prior to the end of the year from the grant of D's patent. Indeed, such a situation as that above outlined might be presented in which C's application was not even filed until after a year from the grant of D's

patent, although C's application was filed within the statutory period of two years after C had placed his invention on the market. In such circumstances, C would have no remedy whatever and would be wholly deprived of any form of protection for his invention, whereas D who had invented nothing but had patented an invention communicated to him by C, would have a patent which would be beyond attack from anyone not informed of D's duplicity.

(3) A valuable invention was made by E early in 1917 in some art like wireless telegraphy in which the services of experts were of the greatest value to this country in the conduct of the European War. Shortly after E had filed an application for patent covering his invention, he answered the call of his country and was sent to France; and his attorney, who was equally patriotic, volunteered his services and was sent to Washington for service in the War Department. While they were so engaged in their patriotic work, an application for patent for the same invention was filed by F, a patent was issued to F for the invention, and E and his attorney did not become aware of F's patent until after a year from the grant of that patent had elapsed and after they had concluded their war service and had returned to their former occupations. The doctrine of estoppel as announced by the Court of Appeals of the District of Columbia would then prevent E from presenting in his application the claims of F's patent and from contesting with F an interference proceeding designed to determine who made the invention first. The enforcement of the estoppel in such a case might operate to deprive E partially or entirely from protection in the invention made by him and put him to

great expense in defending a claim of infringement of F's patent, and the cause of all this would be found in the fact that E was patriotic and gave his services to his country, whereas F was selfish and devoted the months of the war wholly to his own interests.

Section 4886 of the Revised Statutes specifically provides that an inventor may defer filing an application for patent for his invention for two years after placing his invention upon the market. The estoppel here under review would, in some cases, operate to completely nullify the provisions of the Statute. Suppose an inventor did take advantage of this provision by waiting until two years after placing his invention on sale before filing his application for patent and that in the first of those two years a patent was granted to another for the same invention. When the application of the true inventor was filed and came before the Patent Office for examination, it would be met with a rejection based on this estoppel; the applicant would be told that he could not have a patent, notwithstanding the fact that he was the first inventor and had complied with the requirements of the Statutes, because more than a year earlier a patent had been granted to someone else who was not the first inventor. This would be true even if the first patentee had derived all his knowledge of the invention from the first inventor. Thus a Statute of the United States would be made to give way to a ruling of a Court.

It is sometimes attempted to justify this doctrine of estoppel announced by the Court of Appeals of the District of Columbia on the ground that it will force applicants for patents to prosecute their applications more vigorously. Doubtless the Court of Appeals of the District of Col-

umbia has had many applications for patents brought before it which had been pending in the Patent Office for many years. It may be freely agreed that applications should not be allowed to pend so long. If an application may be filed at any time within two years after the invention is made and put into use, as is permitted under Section 4886 of the Revised Statutes, and if the application pends in the Patent Office for say six years, and if the patent then granted runs for seventeen years, it is evident that the monopoly secured by the patent does not terminate until twenty-five years after the invention was made. It may be admitted that a continuance of the monopoly over that period is unjust to the public and was not contemplated when our patent laws were framed But the law as it now stands permits an inventor to defer applying for a patent for two years. Also, the law as it is now framed permits an applicant for a patent to defer for one year the filing of a reply to a rejection of his application by the Patent Office. If those provisions of the law permit a course which is unjust to the public, the change should be made by legislation and not by the judiciary branch of our government. Prior to 1898, the law permitted an applicant for patent to defer for *two* years the filing of a reply to a rejection of his application by the Patent Office. In time it became recognized that this provision of the law permitted of abuse which caused applications for patents to pend in the Patent Office for ten years or even more. The remedy for this situation was applied in the only proper way, by a change in the law which reduced the time permitted to an applicant for reply to a Patent Office rejection from two years to one year. If the abuse which was possible to 1898 is still possible in a less

degree, the change necessary to prevent it should be made in the same way, that is by change in the law to further reduce the period of time allowed for reply to rejections by the Patent Office. In like manner, if it be found advisable to preclude an applicant for patent from inserting in his application the claims of a patent which had been issued for more than a year, the doctrine of estoppel announced by the Court may be enacted into law by the legislative body. But the enforcement of the estoppel by the Court while it is not embodied in the patent law of the country is judicial legislation and as such should not be approved.

Respectfully submitted,
PENNIE, DAVIS, MARVIN & EDMONDS,
Solicitors for Fuller Engineering Company.

JOHN C. PENNIE,
DEAN S. EDMONDS,
CHARLES J. O'NEIL,
Of Counsel.

New York, N. Y. December 9, 1919.

FILED
DEC 15 1919
JAMES D. MAHER,
CLERK.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1919.

No. 117.

MATTHEW T. CHAPMAN AND MARK C. CHAPMAN,
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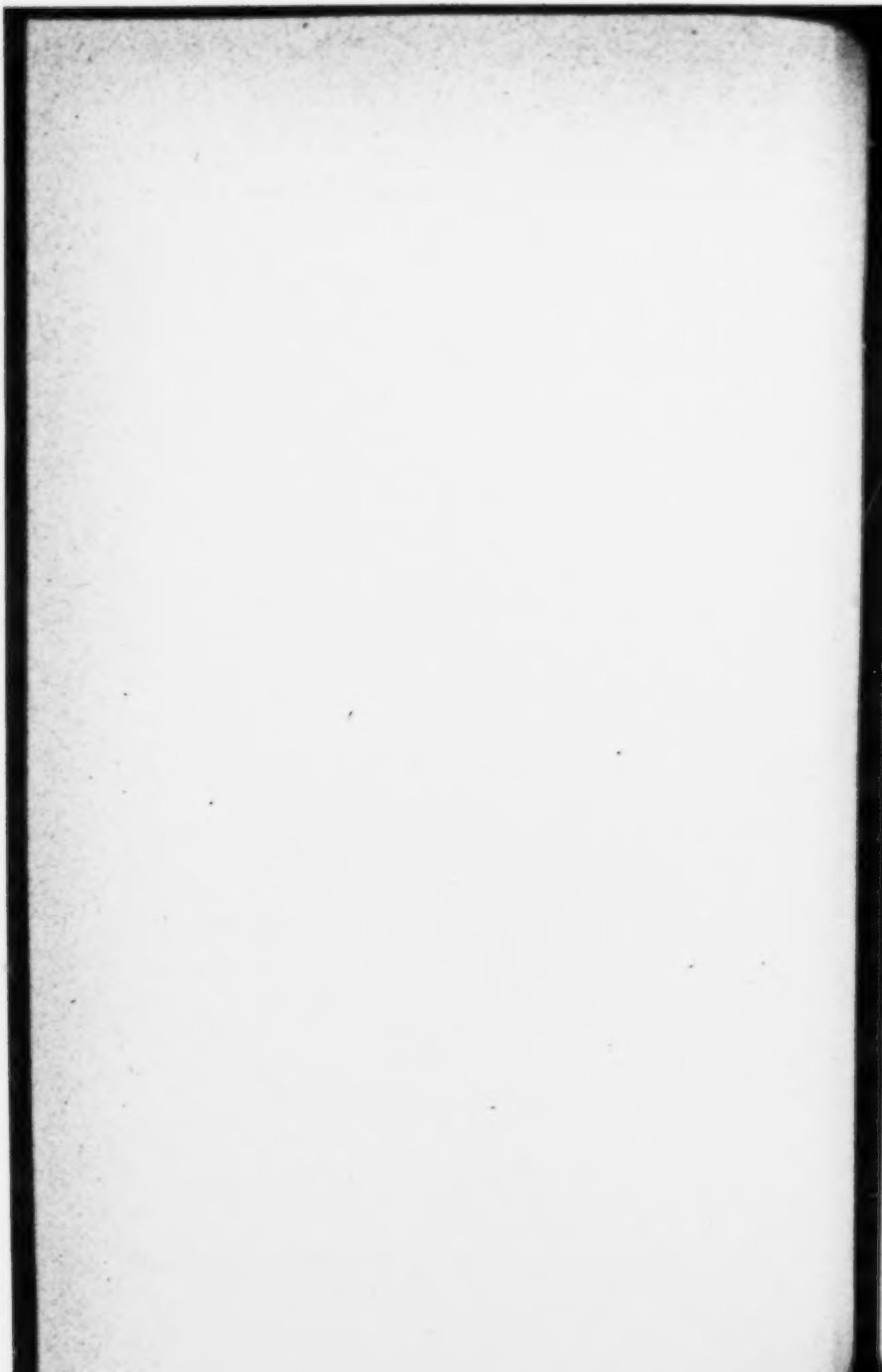
v.

JOHN A. WINTROATH,
Respondent.

MOTION FOR LEAVE TO FILE BRIEF, AS *AMICUS CURIAE*, AND BRIEF.

MELVILLE CHURCH, ESQ.,
Washington, D. C.

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.



IN THE

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OCTOBER TERM, 1919.

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JOHN A. WINTROATH,
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Gentlemen:

Take notice that on Monday, December 15, 1919, on the opening of the Court on that day, or as soon thereafter as counsel may be heard, I shall submit the accompanying motion for leave to file the accompanying brief, as *amicus curiae*, in the above-entitled cause. You are invited to present, at that time, your objections to the granting of such motion, if any you have.

MELVILLE CHURCH.

To
JOHN L. JACKSON,
ALBERT H. ADAMS,
A. V. CUSHMAN,
Counsel for Petitioners,
PAUL SYNNESTVEDT,
Counsel for Respondent.

Service acknowledged this 9th day of December, 1919.

JOHN L. JACKSON,
ALBERT H. ADAMS,
Counsel for Petitioners.

PAUL SYNNESTVEDT,
Counsel for Respondent.

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MOTION

And now comes Melville Church, in his own proper person, and moves for leave to file the accompanying brief, as *amicus curiae,* in the above-entitled cause.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1919.

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BRIEF FILED BY MELVILLE CHURCH, ESQUIRE, AS *AMICUS CURIAE.*

I. The question of far-reaching importance, in this case, may be put thus:

> Is an applicant for a patent barred of his right to a patent simply because a patent for the same invention had already been granted and issued to another more than one year before he applied?

II. Upon the proper answer to this question depends the fate of a large number of applications for patents now involved in contested proceedings in the Patent Office and in the Courts, and of a still larger number of applications that stand rejected.

III. (*a*) In the interference case of Wells & Hunter vs. Honigmann, now pending in the Court of Appeals of the District of Columbia and designated as Patent Appeals Docket No. 1257, relating to improvements in Printing Presses, and in which the writer of this brief appears as counsel for the appellants, the Commissioner of Patents, applying the doctrine laid down by the Court of Appeals of the District of Columbia, in Rowntree vs. Sloan, 45 App. D. C., 207, and in Wintroath vs. Chapman & Chapman, 47 App. D. C., 428 (the case at bar), held that the grant of a patent to Honigmann, on October 7, 1913, upon an application filed by him December 26, 1911, barred the grant of a patent to Wells & Hunter, because, although the application of Wells & Hunter was filed December 6, 1907, the literal claims of the Honigmann patent were not made by Wells & Hunter until 17 months after the issue of the Honigmann patent. That case, upon motion of appellants, has been, by order of the Court of Appeals, put at the foot of the calendar of January Term, 1920, to await the decision of this Court in the case at bar.

(*b*) In the interference case of de Ferranti vs. Harmatta, relating to improvements in Electric Welding, now pending before the Commissioner of Patents, in person, and in which the writer of this brief appears for the appellant, the Board of Examiners-in-Chief has ruled that, although de Ferranti's date of invention is May 25, 1903, by virtue of a British patent granted to him on that date, while Harmatta's date of invention is December 3, 1903, de Ferranti is, nevertheless, barred from the right to a patent because he did not make the literal claims in interference until December 6, 1910, or about 17 months after the issue of a patent containing such claims to one Rietzel, *a third party not involved in the interference*, on July 20, 1909.

Upon motion made to the Commissioner in that case an

order has been entered postponing the hearing before him for 60 days, to await the determination of this Court in the case at bar, settling the point of law involved.

(c) In the case of Thomson Spot Welder Company vs. Ford Motor Company, now pending in the United States District Court, for the Eastern District of Michigan, Southern Division, which is a suit brought for the infringement of the Harmatta Electric Welding patent, and in which the writer of this brief appears as counsel for the defendant, there are involved the same issues of priority and right to patent predicated of the work of de Ferranti that are involved in the interference case of de Ferranti vs. Harmatta, pending in the United States Patent Office, last above noted. In that suit there has been a final hearing and the Court now has the case under advisement, but will doubtless withhold its decision until the determination of the critical point of law referred to in the case at bar.

IV. From the above few instances of many that might be brought to the attention of the Court, this Court may gain an idea of the far-reaching importance of the question it has before it, and of the vital interest which the clients of the writer of this brief and a larger number of others have in the proper determination of such question.

V. The necessary and inevitable effect of the new doctrine announced by the Court of Appeals of the District of Columbia, of which complaint is made, is to add a new bar to the grant of a patent which the statute not only does not provide, but which it plainly negatives.

The statute very explicitly states the necessary prerequisites to the grant of a patent:

> "Sec. 4886. Any person who has invented or discovered any new and useful art, machine, manufacture,

> or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fee required by law, and other due proceedings had, obtain a patent therefor."

VI. It appears by plain implication from a reading of this statute that an applicant may

> (*a*) put his invention into public use or on sale for full two years before applying for his patent; or
>
> (*b*) delay applying for full two years after the patenting or publication of the invention in this or any foreign country,

without being barred of his right to a patent.

VII. To hold, therefore, that the mere grant of a patent to another *one year* before he applies shall itself constitute a bar to an applicant is to, in effect, deprive an applicant of his two-year period of permissive public use and of his two-year permissive delay in applying after patenting or publication in this country or elsewhere, accorded him by the statute, with the result, that not only is a new prerequisite to the grant of a patent created, but two permissions guaranteed by the statute are taken away.

Such an attempt at judicial legislation it is not thought will be tolerated by this Court.

VIII. The other ramifications of the question are so exhaustively and admirably treated in the brief filed by the petitioners that they will not be further discussed herein.

The main purpose of this interposition will have been served if the Court is impressed with the far-reaching importance of the change that has been wrought by the rulings of the Court of Appeals of the District of Columbia, complained of.

MELVILLE CHURCH.

Dec. 4, 1919.